

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT Application of Mills

Group Art Unit: 1745

Application No. 09/009,294

Examiner: Kalafut

Filed: January 20, 1998

For: HYDRIDE COMPOUNDS

* * * * *

Filed Via Facsimile

November 19, 2001

**REQUEST FOR RECONSIDERATION
OF DECISION ON PETITION**

Director Jacqueline M. Stone
Technology Center 1700
United States Patent and Trademark Office
Washington, D.C. 20231

Director Stone:

Applicant kindly requests reconsideration of the Decision on Petition (Paper No. 37) denying Applicant's request to withdraw the finality of the Office Action mailed July 3, 2001.

I. Introduction

The PTO, through its Decision, effectively punishes Applicant for merely having requested a full and fair consideration of experimental data and other technical evidence that had been of record for almost 4 years in this case. The "Secret Committee," which is now prosecuting the subject application, for the first time took a position on that evidence in a Final Rejection, contrary to PTO rules, in what appears to be yet another attempt to subvert Applicant's technology.¹

The Decision, however, completely ignores these and other relevant facts, thus

¹ Applicant's March 1, 2001 response in this case provides background as to the genesis of the "Secret Committee" and some of the other unfair procedures that have been invoked against Applicant in prosecuting this and other BlackLight applications.

failing to even respond to the grounds on which Applicant's Petition was based. Instead, it merely maintains that the Final Rejection is based on the same statutory grounds and the same reasoning as the first Office Action, and responds to other evidence and arguments submitted by Applicant that have no bearing on whether the finality of that rejection was premature. As such, the Decision should be withdrawn and the Petition granted for the reasons set forth therein and as further explained below.

II. Applicant's Petition Made A Compelling Case for
Withdrawing the Finality of the July 3 Office Action

Applicant's Petition lays out in considerable detail the factual and legal bases for withdrawing the premature finality of the July 3 Office Action, as it introduced new substantive grounds of rejection that were neither necessitated by amendment of the claims, nor based on information submitted in an information disclosure statement. Because the Decision fails to even acknowledge the underlying relevant facts that inextricably lead to that conclusion, let alone consider them, a brief summary of those facts is in order.

As noted in Applicant's Petition, Examiner Kalafut thoroughly reviewed the scientific evidence of record and, based on that review, found this application to be in condition for allowance. Following the controversial withdrawal of this application from issuance, the PTO, through its "Secret Committee," issued a first Office Action, dated September 1, 2000, rejecting all claims under 35 U.S.C. §§ 101 and 112.² Applicant's Response, dated March 1, 2001, noted several deficiencies in that Office Action without amending the claims, particularly the Secret Committee's failure to consider the scientific evidence already made of record and its failure to adequately address supposed shortcomings in Applicant's theory underlying his claimed invention.

² The withdrawal of BlackLight's applications from issue resulted in District Court litigation, which case is pending on appeal at the Federal Circuit. [*BlackLight Power, Inc. v. Q. Todd Dickinson*, No. 00-1530]

The Petition further noted the Secret Committee's attempt—unsuccessful though it was—to overcome those deficiencies in its July 3 Final Office Action. Applicant provided specific examples demonstrating how, in that action, the Committee unfairly raised new substantive grounds of rejection by addressing for the very first time record evidence and other previously submitted technical information that should have been addressed in its first Office Action. Applicant further cited numerous examples of new state-of-the-art books and journals that were relied upon by the Secret Committee and newly-minted arguments that also could have and should have been presented earlier so as to develop a clear issue prior to appeal.

For these and other reasons more fully developed in the Petition, Applicant argued that the finality of the July 3 Office Action was premature and should be withdrawn.

III. The Decision Completely Ignores Relevant Facts and Fails to Respond to the Grounds on Which Applicant's Petition was Based

Incredibly, the Decision does not so much as mention a single relevant fact that formed the basis for Applicant's Petition.³ Rather, the Decision conveniently ignores these facts in arguing that the Final Rejection was proper because it was based on the same statutory grounds as the first Office Action:

In the instant case, no new ground of rejection was applied by the examiner in the final office action. The 35 USC 101 and 112, first paragraph rejections were the same as those in the previous non-final action. . . . [Decision at 2]

That argument, however, is nonsensical and misinterprets the PTO's procedural guidelines on this issue, found in MPEP § 706.07(a), which provide in pertinent part:

³ Inasmuch as the PTO is not disputing any of these facts, they must be accepted as true.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement. [Emphasis added.]

The problem with the Decision is that it improperly equates the introduction of a "new ground of rejection" with the raising of a new statutory basis for rejection. That is not the correct standard to be applied in considering whether an Office Action was prematurely made final. The Decision compounds this error by completely ignoring Applicant's Petition arguments showing that the Final Office Action introduced new substantive grounds of rejection under the same statutory provisions, i.e., Sections 101 and 112.

As the PTO well knows, a "new ground of rejection," as referred to in Section 706.07(a), does not require that a new statutory basis be raised. Indeed, the MPEP recognizes situations in which a subsequent Office Action raising a new substantive basis for a rejection, even under precisely the same statutory provision as a prior Office Action, must be made non-final. For example, a second Office Action introducing a rejection under 35 U.S.C. § 103 based upon newly cited art, not necessitated by amendment, would not be made final simply because the claims were previously rejected under that same statutory basis for obviousness. [MPEP § 706.07(a)]

Rejections issued under Sections 101 and 112 are no different and, therefore, should be afforded the same treatment. The PTO's refusal to even consider this aspect of Applicant's Petition is just another example of the arbitrary and capricious way it has handled this case and related applications.

In what seems a desperate grasping at straws, the Decision refers to the fact that the examiner [in actuality the Secret Committee] "specifically referred back to [the] non-final Office action for the reasoning behind the rejections." [Decision at 1.] While that may be technically true, it does not change the fact that additional reasoning was provided as a basis for the final rejection of claims. More significantly, those reasons

were presented for the first time in response to Applicant's specific criticism of the Secret Committee for not providing that reasoning in the first Office Action. Again, that was the basis for Applicant's Petition and simply ignoring these relevant facts will not make them go away.

In apparent recognition that the Final Rejection does in fact present additional reasoning, the Decision asserts that because this reasoning was submitted in response to Applicant's arguments, it should not be considered a new ground of rejection:

The arguments put forth by the examiner do not constitute a new ground of rejection in that they merely respond to arguments presented by Applicant and do not change the basis for the rejections (i.e. the rejections are still based on lack of novelty and enablement as set forth in the previous office action.) [Decision at 2.]

Such argument again simply ignores the fact that among the arguments the Secret Committee addressed for the first time in its Final Rejection were those criticizing its failure to consider the scientific evidence already of record and other technical information. The incredible irony here is that, after acknowledging Applicant's criticisms by supplementing its first Office Action with additional reasoning, the PTO then justifies the finality of this subsequent action by claiming it was merely done in response to Applicant's arguments. While that may be true in a hyper-technical sense, it is simply not a fair representation of the facts in this case.

Applicant further notes that the Decision cites a portion of MPEP § 706.07 that provides: "Before final rejection is in order a clear issue should be developed between the examiner and applicant." The problem with the Decision, however, is that it refuses to even acknowledge, much less analyze, the relevant facts in the case showing that a clear issue had not been developed prior to Final Rejection. The Decision further neglects to cite the additional portion of Section 706.07 providing that:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

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The Decision's failure to even address the relevant facts presented as the basis for Applicant's Petition is but another example of the PTO's reluctance to provide such a full and fair hearing.

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IV. Conclusion

Based on the foregoing reasons, the Decision on Petition should be reconsidered and modified to grant Applicant's request that the finality of the July 3 Office Action be withdrawn as premature.

Respectfully submitted,
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Examiner: Kalafut

Filing Date: 1/20/1998

Title: HYDRIDE COMPOUNDS

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Paper Number 37

In re application of
Randell L. Mills.
Serial No. 09/009,294
Filed: January 20, 1998
For: HYDRIDE COMPOUNDS

DECISION ON
PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed July 3, 2001.

On September 1, 2000, a non-final office action was mailed to applicant (paper no. 27). The office action contained a rejection of all the claims under 35 USC 101 as lacking utility and 35 USC 112, first paragraph as lacking enablement.

A reply to the office action was filed by Applicant on March 1, 2001. In the reply, no amendments were made to the claims. Applicant presented arguments in an attempt to overcome the aforementioned rejections. Additionally, a declaration under Rule 132 was filed on June 22, 2001.

On July 3, 2001 a final office action was mailed (paper no. 34). All of the previous grounds of rejection were maintained.

Petitioner has argued that the finality of the last office action is improper. Petitioner argues that the finality is premature due to the introduction of new grounds of rejection that were neither necessitated by amendment of the claims, nor based on information submitted in an information disclosure statement. Additionally, it is argued that a clear issue between applicant and examiner has not been developed.

DECISION

The non-final office action mailed September 1 2000 contained rejections over claims 1-299 under 35 USC 101 and 35 USC 112, first paragraph. The office action presented arguments as to why the claims lack utility and enablement under the appropriate statute. Applicant's response to this office action, filed March 1, 2001 attempted to rebut the positions set forth in the September 1, 2000 office action. In the final office action mailed July 3, 2001, the examiner maintained the previous grounds of rejection of claims 1-299 and specifically referred back to non-final Office action for the reasoning behind the rejections (see final office action, page 2, lines 2 and 3). In addition, the examiner responded to Applicant's arguments in a separate section (see final office action - Attachment). In the attachment, the examiner addressed the arguments set forth by Applicant in the response filed March 1, 2001 and the Rule 132 declaration. As to the first issue of premature finality, the MPEP states the following:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)

In the instant case, no new ground of rejection was applied by the examiner in the final office action. The 35 USC 101 and 112, first paragraph rejections were the same as those in the previous non-final action (in fact the examiner refers back to the previous office action for the reasoning in making the rejections). The arguments put forth by the examiner do not constitute a new ground of rejection in that they merely respond to arguments presented by applicant and do not change the basis for the rejections (i.e. the rejections are still based on lack of novelty and enablement as set forth in the previous office action).

As to the second issue of premature finality, the MPEP states the following:

Before final rejection is in order a clear issue should be developed between the examiner and applicant.

In the present case, a clear issue has in fact been developed between the examiner and applicant. In the non-final action mailed September 1, 2000, the only grounds of rejection were the 35 USC 101 and 35 USC 112, first paragraph rejections mentioned above. The examiner set forth reasoning to support these rejections. Applicant then replied to the rejections and the positions of the examiner. The rejections were maintained in the final office action and the examiner answered the arguments filed by applicant relating to the issue of whether the claims were lacking in utility and enablement. The issues in the present application are clear - whether the claims lack utility and are enabled to one of ordinary skill in the art.

Accordingly, the examiner properly made the July 3, 2001 Office action final.

The Petition is **DENIED**.



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